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EXAMINER
SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,413

Applicant(s)

LAWRENCE ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 23-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Original claims 1-25 have been examined. The restrictions and rejections are stated below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Invention I: The claims 1-22 are drawn to a method and system for managing risk related to an online transaction.

Invention II: The claims 23-25 are drawn to a method of interacting with a network access device so as to manage risk relating to an online transaction.

3. Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as managing risk related to online transaction without necessarily using the method of interaction with a network access device recited in invention II. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Mitchell Keller on January 2, 2003 a provisional election was made without traverse to prosecute the invention of method and System for managing risk related to an online transaction, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-7, 9-18, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Basch et al (US Patent 6119103).

With reference to Claim 1, Basch teaches a computer-implemented method for managing risk related to an online transaction, the method comprising: gathering data generally related to risk variables associated with the online transaction; receiving information relating details of the online transaction; structuring the information received according to risk score criteria; and calculating a risk score referencing the structured information and the gathered data. (See Basch claim 1) The risk score is interpreted to include a risk quotient also.

With reference to Claim 16, Basch teaches a computerized system for managing risk associated with an online transaction, the system comprising: a computer server accessible with a network access device via a communications network; and executable software stored on the server and executable on demand, the software operative with the server to cause the system to: gather data related to risk variables for an online transaction; receive information relating to

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details of the online transaction; structure the information received according to risk quotient criteria; and calculate a risk quotient referencing the structured information and the gathered data. (See Basch claim 29) The risk score is interpreted to include a risk quotient also.

Communication network and executable software stored on the server and executable on demand are inherent in the invention of Basch.

With reference to Claim 21, Basch teaches a computer executable program code residing on a computer-readable medium, the program code comprising instructions for causing the computer to: gather data related to risk variables for an online transaction; receive information relating to details of the online transaction; structure the information received according to risk score criteria; and calculate a risk score referencing the structured information and the gathered data. (See Basch claim 19) The risk score is interpreted to include a risk quotient also.

With reference to Claim 22, Basch teaches a method and system with computer data signal embodied in a digital data stream comprising data relating to risk management, wherein the computer data signal is generated by a method comprising the steps of: gathering data generally related to risk variables associated with the online transaction; receiving information relating details of the online transaction; structuring the information received according to risk quotient criteria; and calculating a risk quotient referencing the structured information and the gathered data. (See Basch Figure 1 and Claims 1, 19 and 29) The computer data signal is inherent in the method and system of the invention of Basch.

With reference to Claim 2, Basch teaches a method of claim 1 additionally comprising the step of generating a suggested action responsive to the risk quotient. (See Basch claim 1) The

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step of transmitting the score to an account issuer based on the score is interpreted to include the step of generating a suggested action responsive to the risk quotient.

With reference to Claim 3, Basch teaches a method of claim 2 additionally comprising the steps of: storing the information received, the risk quotient and the suggested action; and generating a diligence report referencing the stored information. (See Basch claims 3-7 and Column 10 lines 24- 32 and 55-60) The reports are interpreted to include diligence reports also.

With reference to Claim 4, Basch teaches a method of claim 3 wherein the diligence report comprises the information received relating to details of the financial transaction and actions taken responsive to the risk quotient. (See Basch Column 13 lines 26-62) The format of the alerts and reports are interpreted to include details of the financial transaction and actions taken responsive to the risk quotient.

With reference to Claim 5, Basch teaches a method of claim 2 wherein the suggested action is additionally responsive to the information received. (See Basch Column 8 lines 2-12) The dispute action is interpreted to include action is additionally responsive to the information received.

With reference to Claim 6, Basch teaches a method of claim 2 wherein the specific filters can be tailored according to a geographic location and for a particular type of transaction. (See Basch Column 16 lines 26-32 and 51-57) Designing filters tailored according to a geographic location and for a particular type of transaction is interpreted to include the step wherein suggested action is directed towards reducing risk related to the online transaction, which involves online market participants from different national jurisdictions.

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With reference to Claim 7, Basch teaches a method of claim 2 wherein the suggested action comprises refusing to perform a transaction. (See Basch claim 6) Denying authorization request is interpreted to include the step of refusing to perform a transaction.

With reference to Claim 9, Basch teaches a method of claim 2 wherein the suggested action comprises notifying an authorized private or public data services. (See Basch Column 9 line 62 – Column 10 line 3) The authorized private or public data services are interpreted to include an authority.

With reference to Claim 10, Basch teaches a method of claim 1 wherein the information received comprises the identity of a high-risk entity and the high-risk entity's relationship to an online market participant. (See Basch Column 12 lines 47-52 and Column 13 lines 40-49)

With reference to Claim 11, Basch teaches a method of claim 1 wherein the information received comprises the identity of public agencies. (See Column 6 lines 24- 31) The public agencies are interpreted to include a secrecy jurisdiction.

With reference to Claim 12, Basch teaches a method of claim 1 wherein the information received is gathered electronically by real-time monitoring of online transactions. (See Basch Column 8 lines 20-22 and Column 8 line 60 – Column 9 line 10)

With reference to Claim 13, Basch teaches a method of claim 1 additionally comprising the step of aggregating risk quotients relating to an online market participant to assess a level of identified risk to which the online market participant is exposed. (See Basch Column 5 line 62 – Column 6 line 8)

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With reference to Claim 14, Basch teaches a method of claim 1 wherein scores are generated for transactions. (See Basch Column 17 lines 9-11) The scores are interpreted to include an average risk quotient associated with a transaction.

With reference to Claim 15, Basch teaches a method of claim 1 wherein the online transaction comprises a sale of goods. (See Basch Column 5 lines 11-15)

With reference to Claim 17, Basch teaches a system of claim 16 wherein the information is received substantially simultaneously with the transactions to be authorized. (See Basch Column 8 lines 20-22) Receiving data substantially simultaneously with the transactions to be authorized is interpreted to include information received via an electronic feed.

With reference to Claim 18, Basch teaches a system of claim 16 wherein the information received is generated by a public agency. (See Column 6 lines 24- 31) The public agencies are interpreted to include a government agency also.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Basch et al (US Patent 6119103).

With reference to claims 19 and 20, Basch teaches a system of claim 16 as described above.

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Basch fails to explicitly teach the steps wherein the network access device is a personal computer or a wireless handheld device.

Official notice is taken that using a personal computer and/or a wireless handheld device to access networks are old and well known in the art. These devices allow the user to efficiently and rapidly communicate with the network.

It would have been obvious to one with ordinary skill in the art at the time of invention to include a personal computer and/or a wireless handheld device to the disclosure of Basch. The combination of the disclosures taken as a whole suggests that it would have helped the user facilitate faster and more efficient communication with the network.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Basch et al (US Patent 6119103) in view of Harris et al (US Patent 2002/0032635).

With reference to claim 8, Basch teaches a method of claim 2 as described above.

Basch fails to explicitly teach the step of blocking access to an online marketplace by a particular online market participant.

Harris teaches the step of shutting off trading ability of a counter party if a certain limit is exceeded. (See Harris abstract) Shutting off trading ability is interpreted to include the step of blocking access to an online marketplace.

It would have been obvious to one with ordinary skill in the art at the time of invention to include the teachings of Harris to the disclosure of Basch. The combination of the disclosures taken as a whole suggests that it would have helped the user save potential losses and expenses by taking timely action against the concerned party.

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
January 22, 2003


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600